



Exhibits

TTAB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD



MARLIN FINANCIAL & LEASING CORP.

10-04-2002

U.S. Patent & TMOfo/TM Mail Rcpt Dt. #70

Petitioner,

v.

Cancellation No. [92]040,944

MARLIN LEASING CORPORATION

Registration Nos. 2,303,854

2,303,855

Registrant.

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TRADEMARK TRIAL AND
APPEAL BOARD

**REGISTRANT'S MOTION TO SUSPEND CANCELLATION
PROCEEDING PENDING THE OUTCOME OF ONGOING CIVIL LITIGATION**

Registrant, Marlin Leasing Corporation ("Registrant"), respectfully requests that the Trademark Trial and Appeal Board suspend the above-identified cancellation proceeding, pending the termination of an ongoing civil action which may be dispositive of the case.

Pursuant to Trademark Rule §2.117, 37 C.F.R. § 2.117, "whenever it shall come to the attention of the Trademark Trial and Appeal Board ["TTAB"] that parties to a pending case are engaged in a civil action which may be dispositive of the case, proceedings before the Board may be suspended until termination of the civil action." Suspension of the proceeding before the TTAB is proper because to the extent that a civil action in Federal district court involves issues in common with those in a proceeding before the TTAB, the decision of the Federal district court is binding. *See e.g., Goya Foods Inc. v. Tropicana Prod. Inc.*, 846 F.2d 848, 852-53, 6 U.S.P.Q.2d 1950 (2d Cir. 1988). Decisions of the TTAB do not have similar preclusive effect upon Federal district courts. *See Questor Corp. v. World Indus., Inc.*, 194 U.S.P.Q. 141, 143 (D. Minn.

1976)(“The value of a Patent Office determination of the right to register is ... not res judicata or binding on this Court.”).

On July 24, 2002 – and more than four full weeks before Petitioner filed its Cancellation Petition with the TTAB – Petitioner filed a civil action against Registrant in the United States District Court for the Middle District of Tennessee (“Tennessee Action”). *See* Complaint dated July 24, 2002 (attached hereto as Exhibit “A”). In the Tennessee Action, Petitioner seeks equitable relief and damages for service mark infringement and unfair competition. Petitioner also seeks cancellation of the trademark registrations owned by Registrant. *See* Exhibit A at 4-6. The registrations that Petitioner seeks to have cancelled in the Tennessee Action are the very same registrations that form the basis of Petitioner’s claim in this Cancellation Proceeding.^{1/}

The issues that are currently being litigated in the Tennessee Action are the same as the issues involved in Cancellation Proceeding. Because the issues involved in both actions are the same, the decision of the Tennessee District Court will be binding upon the TTAB in this Cancellation Proceeding. Accordingly, pursuant to 37 C.F.R. § 2.117 Registrant respectfully requests that the TTAB suspend this Cancellation Proceeding pending the termination of the Tennessee Action.

1/ Registrant filed an Answer and Counterclaim in the Tennessee Action on September 19, 2002. *See* Answer dated September 20, 2002 (attached hereto as Exhibit “B”). Registrant’s Counterclaim seeks that the District Court determine the geographic and/or other extent of the parties’ rights and liabilities in connection with the use and registration of their respective marks and/or names. *Id.* at 13. In the event the District Court determines that Registrant’s registrations should be cancelled, Registrant’s Counterclaim also requests that the District Court enter an Order instructing the Commissioner of the PTO to effectuate a partial cancellation and/or issue Registrant a concurrent use registration, as appropriate. *Id.*

Dated: October 7, 2002

Respectfully submitted,



Leza M. Di Bella

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of **REGISTRANT'S MOTION TO SUSPEND CANCELLATION PROCEEDING PENDING THE OUTCOME OF ONGOING CIVIL LITIGATION** has been mailed by first class mail, postage prepaid, on this 4 day of October, 2002, to the attorneys of record for Petitioner:

Hannah K.V. Cassidy
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Margaret Delacruz



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MARLIN FINANCIAL & LEASING CORP.

Petitioner,

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MARLIN LEASING CORPORATION

Registrant.

Cancellation No. [92] 040944

Registration Nos. 2,303,854
2,303,855

ANSWER

Marlin Leasing Corporation ("Registrant"), by and through its counsel, responds to the Petition for Cancellation of Marlin Financial & Leasing Corp. ("Petitioner"), as follows:

TRADEMARK TRIAL AND
APPEAL BOARD
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1. Registrant admits that one of the registrations that Petitioner seeks to cancel is a registration of the service mark MARLIN LEASING, for use in connection with "lease purchase financing," said mark having been registered on the Principal Register in the name of Registrant on December 28, 1999, being Registration No. 2,303,854. Registrant denies, however, that Petitioner has a right to the requested relief and leaves Petitioner to its proof.

2. Registrant admits that the other registration that Petitioner seeks to cancel is a registration of the service mark MARLIN LEASING & Design, for use in connection with "lease purchase financing," said mark having been registered on the Principal Register on December 28, 1999, being Registration No. 2,303,855. Registrant denies, however, that Petitioner has a right to the requested relief and leaves Petitioner to its proof.

3. Registrant admits that Petitioner alleges in Paragraph 3 of the Petition for Cancellation that Petitioner is located at 6009 Ridgeview Circle, Hixson, Tennessee 37343. Registrant otherwise lacks knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in Paragraph 3 of the Petition for Cancellation, except avers that Petitioner's use of the phrase "equipment leasing and financing" is so vague and overly broad as to constitute a mischaracterization.

4. Registrant lacks knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in Paragraph 4 of the Petition for Cancellation and therefore denies the same and leaves Petitioner to its proof.

5. Registrant lacks knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in Paragraph 5 of the Petition for Cancellation and therefore denies the same and leaves Petitioner to its proof.

6. Registrant lacks knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in Paragraph 6 of the Petition for Cancellation and therefore denies the same and leaves Petitioner to its proof.

7. Registrant denies the allegations set forth in Paragraph 7 of the Petition for Cancellation.

8. Registrant lacks knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in Paragraph 8 of the Petition for Cancellation and therefore denies the same and leaves Petitioner to its proof.

9. Registrant denies the allegations set forth in Paragraph 9 of the Petition for Cancellation.

10. All allegations of the Petition for Cancellation not previously specifically admitted are hereby denied. It is specifically denied that Petitioner is entitled to the relief requested in the Prayer.

AFFIRMATIVE DEFENSES

In further answer to the Petition for Cancellation, Registrant asserts that:

1. Registrant's claim is barred by the doctrine of laches and/or estoppel.
2. In the event the Board finds that Petitioner has established grounds for cancellation of Registrant's registrations, Registrant nevertheless is entitled to concurrent registration of its marks subject only to certain geographic limitations.
3. Registrant will rely on any and all other valid defenses which may be developed through discovery and/or the testimony periods in this cancellation proceeding.

WHEREFORE, having fully answered the Petition for Cancellation herein, Registrant respectfully requests that the Petition for Cancellation be in all respects dismissed with prejudice.

Dated: October 4, 2002

Respectfully submitted,



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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of **REGISTRANT'S ANSWER IN RESPONSE TO PETITION FOR CANCELLATION** has been mailed by first class mail, postage prepaid, on this 4 day of October, 2002, to the attorneys of record for
Petitioner:

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Alexandra T. Mackay
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